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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,180	08/03/2001	Chiaki Senoo	50026/027001	1189

21559 7590 07/27/2007
CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/831,180	SENOO ET AL.	
	Examiner	Art Unit	
	Sheridan L. Swope	1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants' after final response of July 13, 2007 is acknowledged; no claims have been deleted, added, or amended.

Status of claims:

Claims 1-14 are pending.

Claims 9-14 are withdrawn.

Claims 1-8 are rejected.

In response to the rejection of claims 1-8 under 35 USC 101/112, lack of utility, Applicants provide the following arguments.

(A) If a protein includes both the serine and histidine active site signatures, the probability of it being a trypsin-family protease is 100%. Compositions within the scope of the claims have specific and substantial utility as DNA encoding trypsin family serine proteases.

(B) Example 10 of the Utility Guidelines is analogous here because, DNA ligases, trypsin-family serine proteases have well-established, specific, and substantial uses.

(C) Trypsin-like serine proteases, which selectively hydrolyze the C-terminal end of a polypeptide at a basic amino acid residue, play a role in a variety of biological activities.

(D) A high degree of homology is not the only way to determine that a protein belongs to a given class.

(E) The Office's citation of Tucker et al and Moreno et al are not material to the argument. Additional potential activities provide no reason to doubt that the claimed compositions have trypsin-family serine protease activity.

These arguments are not found to be persuasive for the following reasons.

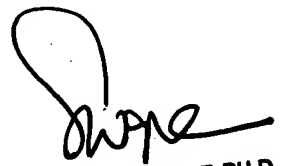
(A) Reply: See reply (B) of the final rejection mailed February 13, 2007.

(B) Reply: See reply (A) of the final rejection mailed February 13, 2007.

(C) Reply: See reply (B) of the final rejection mailed February 13, 2007.

(D) Reply: It is acknowledged that a high degree of homology is not the only way to determine that a protein belongs to a given class. However, neither the specification nor the prior art provide any additional evidence as to the function of the recited DNA and/or the encoded polypeptide.

(E) Reply: It is Applicants who initially argued that alignment of Tespec PRO-2 with acrosin and prostatin provide evidence that Tespec PRO-2 is a trypsin family protease. See remarks of November 27, 2006, page 12, and reply (A) of the final rejection mailed February 13, 2007.



SHERIDAN SWOPE, PH.D.
PRIMARY EXAMINER